PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	10/733,603
Filing Date:	December 11, 2003
Applicant:	Thomas Woodrow Wilson III
Group Art Unit:	1714
Examiner:	Kriellion A. Sanders
Title:	RUBBER COMPOSITIONS WITH NON-PETROLEUM OILS
Attorney Docket:	4022-000016

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Request for Pre-Appeal Brief Review and Petition for Extension of Time

Sir:

In reply to the Final Rejection mailed July 14, 2006, Applicant has filed a Notice of Appeal. Prior to preparation of an Appeal Brief, Applicants respectfully request review.

Applicants hereby petition for a two month extension of time for response and enclose the required fee.

Remarks begin on page 2 of this paper.

REMARKS

Claims 1-60 stand finally rejected. In response to the after final amendment of August 7, 2006 ("After Final Amendment") the Examiner issued an Advisory Action. The Examiner indicated that, while Applicant's reply overcame the obviousness double patenting rejection over Wilson III alone, the remaining rejections are maintained for reasons of record set forth in the Final Rejection.

Applicant appreciates the indication that the obviousness rejection over Wilson III is overcome by the After Final Amendment. However, Applicant respectfully requests review of the Examiner's decision maintaining the other rejections of record. Applicant respectfully submits that his arguments have not been given appropriate weight, and that the claims are in an allowable condition with respect to the cited references.

Double Patenting Over Wilson III Alone

In the final rejection, claims 1-7 and 9-43 are rejected for "double patenting" over claims 1-60 of the Wilson III reference the '871 patent, U.S. (6,620,871). The Examiner has stated, in her Advisory Action, that Applicant's argument after final is sufficient to remove this reference. Attention is respectfully drawn to Applicant's arguments in the After Final Amendment on pages 10 and 11.

Double Patenting Over Wilson III and further in view of Teratani and Hakuta

Claims 1-60 remain rejected for obviousness type "double patenting" over claims 1-60 of the '871 patent in further in view of the Teratani reference and to the Hakuta. The final rejection states the rejection in the same terms as used in the Non-Final Office Action of February 13, 2006. Applicant respectfully submits that the Examiner is applying the secondary references

incorrectly. Attention is drawn to Applicant's arguments in the After Final Amendment on pages 11 and 12.

As developed in Applicant's Amendment of April 24, 2006, the '871 patent does not disclose or claim at least one limitation of the current claims, that being the presence of non-petroleum oil wherein the non-petroleum oil comprises fatty acid side-chains and wherein at least 50% of the fatty acid side-chains have one or more sites of unsaturation. The current claims recite non-zero levels of the non-petroleum oil as explained in the Final Amendment at the bottom of page 10 bridging to page 11.

The Teratani and Hakuta references are apparently being cited for their teachings of non-petroleum oils such as are missing from the '871 patent. The Teratani reference is apparently disclosed for its teaching of a novalak type phenolic resin modified with at least one of animal oil, vegetable oil, or unsaturated oil. See for example, the February 13 Non-Final Rejection at page 6. The same rejection characterizes the Hakuta reference as teaching castor oil to be an effective dripping inhibitor for rubber compositions. See Non-Final Rejection of February 13, 2006, page 6, paragraph 2 and 3.

As developed by Applicant in the amendment of April 24, 2006 (page 12) and in the After Final Amendment on pages 11 and 12, the Teratani and Hakuta references do not disclose or suggest the non-petroleum oil that is missing from the '871 claims. As developed by Applicant, the Teratani reference's disclosure of a novalak type phenolic resin modified with a vegetable oil is <u>not</u> a vegetable oil having more than 50% of the side chains with an unsaturated group. Rather, the oil modified novalak resins of the Teratani references are solids. This is clearly seen in the Teratani reference at column 4 under synthesis example 2. The melting point of the oil modified resin is 80°C. As appreciated by those of skill in the art, the non-petroleum oils of the current claims are liquids at room temperature.

As developed by Applicant in the After Final Amendment, the Hakuta reference does not teach the use of castor oil in rubber compositions, but rather hydrogenated castor oil. It is well known to those of skill in the art that hydrogenated castor oil is saturated and does not contain the level of unsaturation recited in the claims.

Based on the above, it is seen that combining the teachings of the Teratani or Hakuta references with the claims of the '871 patent does not result in the subject matter of the current claims. That is, the combination of references is still lacking a non-petroleum oil having unsaturated side-chains. The Examiner has cited no references containing that limitation, and provides no motivation to modify the combined references to arrive at the subject matter of the rejected claims.

Conclusion

Further and favorable action is urgently solicited. If it would be helpful to resolving any issues, the review board is invited to telephone the undersigned Applicant's representative.

Respectfully submitted,

Dated: Nov 16, 2006

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